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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/065,120

09/18/2002

Scott C. Harris

GPSPrivCI

8217

23844

7590

12/21/2006

SCOTT C HARRIS

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EXAMINER

ISSING, GREGORY C

ART UNIT

PAPER NUMBER

3662

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/21/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/065,120

Applicant(s)

HARRIS, SCOTT C.

Examiner

Gregory C. Issing

Art Unit

3662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,9-13,15,17-20 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9-13, 15, 17-20 and 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3662

1. In view of the Reply Brief filed on 8/8/06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

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THOMAS H. TARCZA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 2, 9-13, 15, 17-20 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zellner et al (6,675,017) in view of either one of Roeder (5,491,745) or Altidor et al (5,894,276).**

Zellner et al teach a wireless handheld device 200 operating over a wireless network 210, (1) wherein the handheld device is exemplified as a cellular telephone (2:5-15), (2) wherein the wireless handheld device includes a position detection module 220 preferably in the form of a GPS receiver (5:60-62), such that position may be reported to a remote location for emergency purposes or for services, (3) wherein the device includes a user interface 202, and (4) wherein the handheld device includes a location block device processor 204. The location block device processor 204 reads on the claimed "override control" because in the embodiment of the location being determined in the handheld device, (1) it is

Art Unit: 3662

actuated by the user to enhance privacy (2:51-60 and 3:14-38), (2) it is manually actuated in response to the user using the user interface (6:1-15, 6:23-29 and 7:54-60), and (3) it can either alternatively (3a) disable a location system and substitute dummy information, which dummy information could comprise substituting no information at all, or (3b) receive location information and substitute dummy information (6:18-30) such that wireless communication from the handheld device to the network continues to operate, thus providing evidence of the continued operation of the wireless handheld device.

Zellner et al differ from some of the variously claimed embodiments while meeting the scope of other embodiments. For example, while Zellner et al disclose a user interface 202 that prompts the user to enter commands wherein the interface may include menu selections, key sequences, and graphical user interfaces, thus teaching a manual actuating mechanism (claim 1), none of the use of "a single button which is pressed to activate a position privacy control" (claim 9) or "override control . . . operating in response to a manual press of a single button on the portable telephone" (claim 10), or "a manual button . . . that is pressed once to enhance security" (claim 21) are ~~not~~ expressly disclosed.

Each of Roeder and Altidor et al teach the conventionality at the time the invention was made to utilize one-touch keying to perform functions on mobile electronic devices. Roeder teaches the conventionality of one-touch recall and dialing in a cellular phone obviating the need for multiple-step key activation (1:56-2:8). Altidor et al teach the conventionality of a customizable or programmable function button that can be associated with an important or frequently used function since it is known to be desirable to minimize the necessary user interaction to achieve a particular function (1:12-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zellner et al to manually activate/deactivate privacy control via an user interface comprising a single key input in view of the teaching of Zellner et al (1) to activate such function via a menu selection, key sequence or graphical user interface and (2) the teaching that the location block processor and the user interface could be a single component (3:32-37), and further in view of the teachings of either one of Roeder or Altidor et al who are exemplary of the fact that one-touch shortcut keys were conventional in wireless communication devices at the time of the invention for the reasons set forth above.

**Claims 1, 2, 9-13, 15, 17-20 and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson et al (5,731,785) in view of Seiple et al (6,222,484) and either one of Roeder (5,491,745) or Altidor et al (5,894,276).**

Lemelson et al teach a remote security system including a portable remote security location device 10 (Figure 2) comprising a wireless telephone 24 (Figure 3), operating for example with the cellular network of Iridium (4:24-25) for reporting position information of the portable device (3:55-57) determined from a location receiver 34 receiving GPS signals (5:46-50), and an user interface 25/26/27 for disabling transmission of the location information without disabling operation of the portable device via the use of an inhibiting PIN actuated by the user (5:7-25), thus effectively equating to the claimed override control limitation. Lemelson et al recognize the desire for privacy in a combined communication device/location device and concomitantly means for providing the security by user actuation (4:44-5:25).

Lemelson et al differ from the claimed subject matter of the embodiment set forth in claim 1 since the override control does not prevent the determination of position but merely prevents the transmission of position, and differ from the subject matter of the embodiments set forth in claims 9, 10 and 20 since the override control is not specified as a single button being manually pressed but rather teaches entry of a PIN number.

Seiple et al teach a portable unit 10 (Figure 2A) housing a GPS receiver 20/26 for determining position of the portable unit and a two-way communication device 21 for communicating and providing tracking between the portable device and a remote base device, thus relating to analogous art. Moreover, Seiple et al teach the use of power management in the portable device to conserve power and allow the device to be made small, via the reduction in the size of the power supply. The power management includes placing the GPS receiver IC and the GPS processor IC in a standby or sleep mode between the times that signals are received from the GPS satellites to obtain a fix (7:37-58).

Each of Roeder and Altidor et al teach the conventionality at the time the invention was made to utilize one-touch keying to perform functions on mobile electronic devices. Roeder teaches the conventionality of one-touch recall and dialing in a cellular phone obviating the need for multiple-step key

Art Unit: 3662

activation (1:56-2:8). Altidor et al teach the conventionality of a customizable or programmable function button that can be associated with an important or frequently used function since it is known to be desirable to minimize the necessary user interaction to achieve a particular function (1:12-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lemelson et al by incorporating the power management control of Seiple et al so as to conserve power and allow reduction in the size of the portable remote security location device as suggested by Seiple et al; the use of the power management control would place the GPS receiver of Lemelson et al into a power saving standby/sleep mode between the times when GPS signals are required for a position fix for position reporting. Since Lemelson et al teach not providing the position information to the monitoring station upon entry of the inhibiting code and the purpose of the position information is for remote monitoring of the portable device, there is clearly no need for the position to be determined upon the user entering the inhibiting mode. In view of the teachings of Seiple et al, if the position fix is not required, the position receiver/processor may be placed into the standby/sleep mode in order to conserve power.

Furthermore, it would have been obvious to the skilled artisan to utilize a single dedicated button in view of the teachings of either one of Roeder or Altidor et al who clearly are exemplary of the fact that one-touch shortcut keys were conventional in wireless communication devices at the time of the invention for the reasons set forth above.

#### Response to Arguments

The Applicant's argument that Zellner et al do not prevent the position detection module from determining position is contrary to the teachings of Zellner et al. Specifically, Zellner et al state "processors 204 and 206 can disable a location system and substitute dummy information or can receive location information and substitute dummy information" (6:22-25) as well as the further teaching "to block location information, location block device processor 204 either disables handheld location system 220 or substitutes dummy information for the location information" (6:26-28); this clearly indicates that the location system in the handheld device can be disabled or that the position information may be determined but not sent. Thus, Applicant's arguments are not commensurate with the complete

Art Unit: 3662

teachings of Zellner et al since Zellner et al clearly teach the disabling of the handheld location system as well as the reporting of dummy information. Moreover, only the embodiment of independent claim 1 (as well as dependent claims 11 and 22) sets forth an override control that prevents the determination of position; each of the remaining independent claims merely set forth preventing the reporting of position information. The arguments are therefore not convincing since Zellner et al perform both types of operation including disabling the location system and prevention of the transmission of location indicative information.

The Applicant's argument that the use of a single button that is pressed to activate position privacy control is not suggested by Zellner et al since all of Zellner et al's blocking means are "much more complicated than the single button" is not persuasive is simply Applicant's opinion. Moreover, each of Roeder and Altidor et al teach the conventionality of the use of short-cut keys in wireless electronic devices.

Regarding the rejection over Lemelson et al, Applicant argues a combination not set forth by the rejection; the combination set forth by the Office merely integrates the teachings of power conservation as taught by Seiple et al into the portable location device of Lemelson et al. Each of the references are directed to portable devices integrating location determination and communication processes, thus the two references are clearly within the scope of one another. Contrary to the Applicant's belief, Seiple et al disclose the placement of the location determining means, i.e. the GPS receiver, into a mode which is described by the terms "dormant", "sleep" or "standby" to provide power conservation. Figures 3.1 (101), 3.3 (301) and 3.5 (501) exemplify the turning off of the GPS subsystem for the various conditions. Since Lemelson et al disclose an application mode wherein user privacy is desired by prohibiting the transmission of location information and thereby not allow monitoring of the location of the user, the non-provision of location information does not thwart, destroy, nor defeat the intent of Lemelson et al; Lemelson et al specifically teach prohibiting someone else from knowing the location of the user by prohibiting the reporting of location information in a system that uses the location information merely for location reporting. The Applicant's reliance on a separate embodiment wherein a user is tracking his vehicle does not negate the additional embodiments of Lemelson et al, and the Applicant's argument is

Art Unit: 3662

therefore not commensurate in scope with the complete teachings of Lemelson et al. Furthermore, the Applicant's allegation that it would make no sense to operate Seiple et al in a way that turned off the GPS is directly contrary to the teachings of Seiple et al who specifically disclose such as set forth above for the purposes of power conservation in a portable device. Neither of the Applicant's arguments, directed to the non-operability of the proposed combination, are persuasive nor are they correct.

Regarding the single button for privacy activation of claims 9, 10 and 20, applicant's argument that a single button would not be useable in Lemelson et al lacks merit. Lemelson et al clearly envision an embodiment wherein the portable device is associated with an actual person who desires not to be tracked for privacy purposes (4:43-59). Applicant's stressing of the use only as a security device for tracking a lost or stolen object is not commensurate in scope with the complete teachings of Lemelson et al. There is nothing in Lemelson et al that would go against the teachings therein via the use of a single button, particularly in the case wherein the person desires privacy from being tracked. As taught by each of Roeder and Altidor et al, the use of short-cut keys to minimize the requirement of user interaction to perform a function in portable electronic devices is well-known. Applicant's argument that there is nothing in Lemelson et al that teach use for position privacy control is again directly contradictory to the teachings of Lemelson et al, see (4:43-47 and 5:7-9).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3662

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Gregory C. Issing  
Primary Examiner  
Art Unit 3662

gci